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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Kaneko, et al.

Serial No.: 09/839,539

Group Art Unit: 2651

Filed: April 23, 2001

Examiner: Wong, Kin C.

For: DISK DRIVE

Honorable Commissioner of Patents  
Alexandria, VA 22313-1450

**REQUEST FOR WITHDRAWAL OF FINALITY OF REJECTION**

Withdrawal of the finality of the Office Action of October 12, 2004 is requested, together with restarting of the period for response to that Office Action.

MPEP §706.07(a) states:

“Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).” (Emphasis added.)

In rejecting the claims, the Office Action relies on Pennock, U.S. Patent No. 4,885,517.

Pennock was first cited in an Office Action dated March 17, 2004, but was not used as a ground of rejection of the claims in the application. In response to that rejection, the claims were amended only as to form. Claim 1, for example, was amended to explicitly recite that certain action takes place when the power voltage goes below a first voltage level smaller than the rating level and to recite that other action takes place when the power voltage goes below a second voltage level smaller than the rating level but greater than the first voltage level.

Prior to that amendment, claim 1 recited that certain action takes place when the power voltage goes below the first voltage level, and that other action takes place when the power voltage is smaller the rating voltage but greater than the first voltage level.

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If the power voltage is smaller than the rating voltage but greater than the first voltage level, then clearly the power voltage is below a second voltage level that is smaller than the rating level but greater than the first voltage level, perhaps only infinitesimally smaller, but nevertheless smaller. Thus, that amendment only affected the form of the claim.

Likewise, if the power voltage is smaller than the rating level but greater than the first voltage level, then the first voltage level is also smaller than the rating voltage, and so that amendment only affected the form of the claim.

Accordingly, the amendment of claim 1 did not necessitate reliance on Pennock to reject the claim.

Turning to claims 8, 9, 14, and 15, those claims were amended only to delete reference to the "first speed" and the "second speed." If anything, these amendments broadened the claims. Thus, these amendments did not necessitate reliance on Pennock to reject claims 8, 9, 14, and 15.

Pennock was clearly a new ground of rejection that was not necessitated by Applicants' amendment of the claims. Pennock was not submitted in an Information Disclosure Statement. Thus, the finality of the rejection was not proper, MPEP §706.07(a), and it should be withdrawn. Such action is respectfully requested.

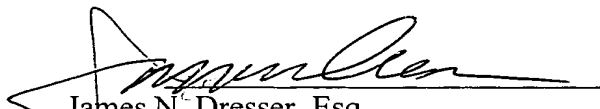
It is also requested that the period for response to the Office Action be restarted with the

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mailing of a paper in response to the present paper which withdraws the finality of that Office  
Action.

Respectfully Submitted,

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